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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mariko Iwasaki

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EXAMINER

VIRANY, LESLIE R

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/568,801	Applicant(s) IWASAKI ET AL.	
	Examiner LESLIE VIRANY	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 22-26 define a program, capable of being executed, embodying functional descriptive material.**[see i.e. the limitation “computer program product” is considered as software for obtaining and specifying destinations, see spec., p. 21]** However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason. (i.e. “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV) That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claims 27-29 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example, in the case of claim 22, the image data acquiring/transmitting method including steps of capturing, acquiring and sending is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of “capturing”, “acquiring” or “sending” to limit the steps to the electronic form of the “image data” and the claim language itself is sufficiently broad to read on a person memorizing a printout of image data sufficiently to extract a piece of information such as the time of day, and , upon asking someone where the information should be recorded, sending it there.

Claim Rejections - 35 USC § 112

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 & 16 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Elements critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). No explanation is provided as to what is entailed by **operation information including information on an accumulation destination which indicates where to accumulate the image data**. Consequently examiner has done his best to examine this claim as presented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claim 1-6, 12 – 16, 19-23, 25, 27-8 & 30 rejected under 35 U.S.C. 102(e) as being anticipated by Hama; Mitsuji (US 20060121850)

Regarding claim 1, Hama discloses a camera having transmission function, the camera comprising: an image data acquisition unit for capturing an image and acquiring data of the image; [Fig. 2, camera unit 4] a storage for storing destination information in advance, the destination information specifying a destination to send the data; and [Abstract, lines 4-7] a transmitter for sending the data to the destination indicated in the destination information stored in the storage [Fig. 2, transmits e-mail step S3].

Regarding claim 2, Hama further teaches comprising a destination information receiver for accepting an entry of the destination information. [0012, line 9, receiving unit]

Regarding claim 3, Hama further teaches comprising a destination information accumulation unit for accumulating the destination information accepted by destination information receiver in the storage. [0025, lines 3-4, storing unit]

Regarding claim 4, Hama further teaches wherein the transmitter sends the data to the destination immediately after capturing the image. [Abstract, lines 7-12]

Regarding claim 5. Hama further teaches, wherein the camera accepts an instruction for capturing an image after accepting an entry of the destination information; [Abstract, lines 4-7] captures the image, [Abstract, lines 7-9] and sends the data to the destination. [Abstract, lines 9-12]

Regarding claim 6, Hama further teaches, wherein the camera makes an inquiry whether or not to send the data before sending the data to the destination, and sends the data to the destination only after receiving an instruction for transmission in response to the inquiry. [Hama Fig. 10 step S39 Note also in ¶0083 that processing is terminated if the camera detects that the end button is pushed, thus preventing transmission. Note further that transmission only proceeds if the response received to inquiry in s39 is negative, thus meeting the limitation.]

Regarding claim 12, Hama further teaches comprising at least one capture button for accepting an instruction on image capture, wherein the storage stores the destination information so that the destination information is related to the capture button respectively; and the transmitter sends the data to a destination indicated in the destination information related to the capture button pressed when pressing of the capture button is accepted. [FIG. 7, the operating buttons associated with the e-mail address]

Regarding claim 13, Hama further teaches comprising at least two capture buttons for accepting an instruction for image capture; [0066, line 1, assigned shutter buttons] wherein the storage stores at least two pieces of operation information so that each piece of the operation information is related to the at least two capture buttons, the operation information being information on an operation when the at least two capture buttons are pressed; and [0022 second operating button] the camera further comprises an operation unit for executing the operation in accordance with the operation information related to one of the capture buttons which is pressed when pressing of one

of the at least two capture buttons is accepted, [0024 button down longer than the predetermined time] and the operation executed by the operation unit includes transmission of captured image data. [0065 control unit 6]

Regarding claim 14, Hama further teaches wherein the operation information includes the destination information, and the operation executed by the operation unit includes transmission of the data to the destination. [0022 second operating button]

Regarding claim 15, Hama further teaches wherein the operation executed by the operation unit further includes accumulation of the data. [0023, line 5 data is stored]

Regarding claim 16, Hama further teaches indicating accumulation destination and the operation executed by the operation unit includes accumulation of the data therein. [0052 work memory note in Fig. 3 contained in camera I/F unit 5 is in communication with control unit 6 which handles mail-packet data used for transmission control]

Regarding claim 19, Hama further teaches wherein when a predetermined operation is executed, the image is captured, and the data is sent to a destination related to the predetermined operation. [FIG. 7, the operating buttons associated with the e-mail address, note operating any one of the predetermined shutter buttons will direct data to that address]

Regarding claim 20, claim 20 is directed towards the imaging device of claim 1 contained in a mobile phone with a microphone and a speaker. Hama further teaches a mobile phone with a microphone and a speaker. [Fig. 2, camera unit 4]

Regarding claim 21, Hama teaches the limitations as discussed above in connection with claim 20 and further teaches a numeric keypad which doubles as a capture button, as claimed.[0046, note that the OK button, which functions in capture mode as the shutter button, is also part of the numeric keypad in that it typically performs the “equals” function as well, thus meeting the limitation] Seki further teaches a mode switchover button. [0046, line 5]

Regarding claim 22, claim 22 is directed towards a program product supporting the use of the device disclosed in claim 1 and is likewise rejected.

Regarding claim 23, is directed towards a program product supporting the use of the device disclosed in claim 3 and is likewise rejected.

Regarding claim 25, is directed towards a program product supporting the use of the device disclosed in claim 13 and is likewise rejected.

Regarding claim 27, claim 27 is directed towards a method of use of the device disclosed in claim 1 and is likewise rejected.

Regarding claim 28, claim 28 is directed towards a method of use of the device disclosed in claim 3 and is likewise rejected.

Regarding claim 30, claim 30 is directed towards a method of use of the device disclosed in claim 13 and is likewise rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 9, 11, 24, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Hama in view of Seki. (US 20010048774)

Regarding claim 7, Hama teaches the limitations as discussed above in connection with claim 1 including storing the transmission condition and the destination information relatively, [Hama Fig. 4, note that entries are related by alphabetical order] and the transmitter sends the data to a destination related to the matched transmission condition and the determination unit . [Hama Fig. 4, note that entries are digitally represented, thus inherently becoming active as destinations when it is determined that the user selects that particular one as destination]

Hama fails to teach determines that the operating information matches a transmission condition, as claimed.

However Seki teaches an operating information acquisition unit for acquiring operating information which is information on an image-capture operation; and [0031] a determination unit for determining whether or not the operating information matches a transmission condition, the transmission condition being a condition for sending the data and also a condition on a capture operation; [0049 “and determines”] wherein the storage stores the transmission condition and the destination information relatively, and the transmitter sends the data to a destination

related to the matched transmission condition when the determination unit determines that the operating information matches.

It would have been obvious to one having ordinary skill in the art at the time of invention to have combined the operating information acquisition unit of Seki in the camera having transmission function of Hama in order to provide branched control of transmitted image data in the camera of Hama as explicitly taught by Seki.

Regarding claim 9, Hama in view of Seki teaches the limitations as discussed above in connection with claim 7. Seki further teaches wherein the transmission condition includes a condition on number of capture operations. [Fig. 7b note guide list provides a definite number of required pictures to take]

It would have been obvious to one having ordinary skill in the art at the time of invention to have combined the operating information acquisition unit of Seki in the camera having transmission function of Hama in order to provide branched control of transmitted image data in the camera of Hama as explicitly taught by Seki.

Regarding claim 11, Hama in view of Seki teaches the limitations as discussed above in connection with claim 7. Seki further teaches a capture button for accepting an instruction on image capture, wherein the transmission condition is a condition on a pressing time of the capture button. [Fig. 25 step S148 Note that the image capture guide list sets requirements on images to be taken while, for example, covering a scheduled event for a newspaper and therefore a time requirement is fairly suggested]

It would have been obvious to one having ordinary skill in the art at the time of invention to have combined the operating information acquisition unit of Seki in the camera having transmission function of Hama in order to provide flexible branched control of transmitted image data in the camera of Hama as explicitly taught by Seki.

Regarding claim 24, claim 24 is directed towards a program product supporting the use of the device disclosed in claim 7 and is likewise rejected.

Regarding claim 29, claim 29 is directed towards a method of use of the device disclosed in claim 7 and is likewise rejected.

3. Claims 17, 18, 26 & 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Hama in view of Okamoto. (US 6633231)

Regarding claim 17, Hama teaches the limitations as discussed above in connection with claim 1 including a unit for determining whether operating information matches a condition stored for capturing and transmitting and destination information indicator related to a matched condition. Hama does not explicitly disclose operating information the transmitter sends the data to the destination indicated in the destination information related to a matched condition when the condition is determined to matched by the determination unit.

However Okamoto teaches an operating information acquisition unit for acquiring operating information, the operating information being information on which the camera is operated; [Col. 23, lines 37 - 49 Note operations of setting, etc.]

It would have been obvious to one having ordinary skill in the art at the time of invention to have combined the destination information matching unit of Okamoto in the camera having transmission function of Hama in order to provide branched control of transmitted image data in the camera of Hama as explicitly taught by Okamoto.

Regarding claim 18, Hama in view of Okamoto teaches the limitations as discussed above in connection with claim 17. Hama further teaches a plurality of operation buttons, wherein the operating information is a sequence of pressing the operation buttons. [0025 Note that, for example, a user may press a button to operate to store the destination address and sequentially thereafter press a different button to operate to capture and transmit the image]

Regarding claim 26, claim 26 is directed towards a program product supporting the use of the device disclosed in claim 17 and is likewise rejected.

Regarding claim 31, claim 31 is directed towards a method of use of the device disclosed in claim 17 and is likewise rejected.

4. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Hama in view of Seki in further view Okamoto.

Regarding claim 8, Hama in view of Seki teaches the limitations as discussed above in connection with claim 7, including plural destinations and image transmissions. Hama in view of Seki fails to teach that plural destinations are related to different image data through transmission conditions as claimed.

However Okamoto teaches, wherein: the transmission condition is one of a plurality of transmission conditions, the destination information is one of a plurality of pieces of destination information [Col. 5, lines 3-5, note that the destination is selected], and the plurality of pieces of destination information are respectively related to the plurality of transmission conditions; [Col. 11, lines 50-58] the storage stores the plurality of transmission conditions and the plurality of pieces of destination information; [Col. 3, lines 25-28]the determination unit determines whether or not the operating information matches at least one of the plurality of transmission conditions;[Col. 3, lines 20-28, note circumstances of event determine course of response] and the transmitter sends the data to a destination indicated in each piece of the destination information respectively related to at least one transmission condition which is determined to be matched by the determination unit. [Fig. 7, comparator 26 & judging section 27]

It would have been obvious to one having ordinary skill in the art at the time of invention to have combined the destination information matching unit of Okamoto in the camera having transmission function of Hama in view of Seki in order to provide branched control of transmitted image data in the camera of Hama in view of Seki as explicitly taught by Okamoto.

5. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Hama in view of Seki in further view of Hadell. (20040126015)

Regarding claim 10, Hama in view of Seki teaches the limitations as discussed above in connection with claim 7. Neither Hama nor Seki explicitly teaches temporally constrained image-taking as claimed.

However Hadell teaches wherein the transmission condition is a condition on number of captures per unit time.[0051, lines 3-5]

It would have been obvious to one having ordinary skill in the art at the time of invention to have combined the real-time image transmitter of Hadell in the camera with branched transmitted control of Hama in view of Seki in order to provide real-time branched transmission of image data in the camera of Hama in view of Seki as explicitly taught by Hadell.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE VIRANY whose telephone number is (571)270-5893. The examiner can normally be reached on M-Th 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571)272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LV

/Lin Ye/
Supervisory Patent Examiner, Art Unit 2622